

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* RAYMOND F. WATTS and PHILIP REEVE

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Appeal No. 1999-2844  
Application 08/813,530

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ON BRIEF

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Before OWENS, WALTZ and JEFFREY T. SMITH, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

*DECISION*

This appeal is from the final rejection of claims 1-18, which are all of the claims in the application.

*THE INVENTION*

The appellants claim a lubricating composition comprising a lubricating oil and a specified additive combination for lubricating a continuously variable transmission, and also claim the additive combination and a method for lubricating a

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continuously variable transmission using the lubricating composition. Claim 1, directed toward the lubricating composition, is illustrative and is appended to this decision.

#### *THE REFERENCES*

Le Suer	3,197,405	Jul. 27, 1965
Gutierrez et al. (Gutierrez)	5,320,768	Jun. 14, 1994
Bloch et al. (Bloch)	5,641,732	Jun. 24, 1997
		(filed Jul. 17, 1995)

#### *THE REJECTIONS*

The claims stand rejected under 35 U.S.C. § 103 as follows: claims 1-3, 6-8 and 11-18 over Gutierrez in combination with Le Suer, and claims 1-18 over Gutierrez in combination with Le Suer and Bloch.

#### *OPINION*

We reverse the aforementioned rejections. We need to address only independent claim 1.<sup>1</sup>

Gutierrez discloses a lubricating composition which is particularly suitable for use in automatic transmissions and includes as a friction modifying additive a hydroxy ether amine compound having a specified general formula (col. 1, lines 14-21; col. 10, lines 29-59; col. 11, lines 50-65). The general formula

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<sup>1</sup> Claim 16, which is the only other independent composition claim, claims the additive combination recited in claim 1 (except for excluding the option of component (2)(c)(3) being the reaction product of an ethoxylated amine with a boron compound). Claim 18, which is the sole method claim, recites a method for lubricating a continuously variable transmission using the composition of claim 1.

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includes compounds within the component (2)(c)(3) general formulae in the appellants' claim 1. Gutierrez's lubricant composition can contain, as an anti-wear additive, an organic phosphite ester having a specified general formula (col. 12, lines 13-32) which includes organic phosphites within the second component (2)(a) formula in the appellants' claim 1. Gutierrez does not disclose a compound within the component (2)(b) general formula in the appellants' claim 1.

The examiner argues that "LeSuer teaches amine salts of phosphates which encompasses the amine salt component of the instant claims, component (b), as set forth in the specification on page 13" (answer, page 4). The appellants state in their specification (page 13, lines 9-18) that a particularly useful class of amine salts of phosphates is prepared as described in Le Suer. These amine salts of phosphates, however, are not the ones recited in the appellants' claims. As stated by Le Suer (col. 1, lines 54-55) and indicated by the structure in the appellants' specification (page 13, line 17), each of Le Suer's amine salts of phosphates must contain a sulfur atom. Component (2)(b) in the appellants' claim 1, which is a different embodiment in the appellants' specification (page 10, lines 10-26) than that relied upon by the examiner, has no sulfur atom.

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The examiner relies upon Bloch only for an additional disclosure of the appellants' component (2)(c)(3) (answer, page 5), and not for a disclosure which remedies the above-discussed deficiency in Gutierrez and Le Suer as to component (2)(b).

The examiner, therefore, has not set forth a factual basis which is sufficient to support a conclusion of *prima facie* obviousness of the invention recited in any of the appellants' claims. Accordingly, we reverse the examiner's rejections.

#### DECISION

The rejections under 35 U.S.C. § 103 of claims 1-3, 6-8 and 11-18 over Gutierrez in combination with Le Suer, and claims 1-18 over Gutierrez in combination with Le Suer and Bloch, are reversed.

#### REVERSED

Terry J. Owens	)	
Administrative Patent Judge	)	
	)	
	)	BOARD OF PATENT
Thomas A. Waltz	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
Jeffrey T. Smith	)	
Administrative Patent Judge	)	

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## Appendix

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